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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Kelvin G.M. BROCKBANK et.al.

Group Art Unit: 1636

Application No.: 09/835,818

Examiner: W. Sandals

Filed: April 17, 2001

Docket No.: 105452

For: CYCLOHEXANEDIOL CRYOPROTECTANT COMPOUNDS

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TECHNOLOGY CENTER 1700**RESPONSE TO RESTRICTION AND
ELECTION OF SPECIES REQUIREMENT**

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Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

In response to the Restriction and Election of Species Requirement mailed June 17, 2002, Applicants elect to prosecute the claims of Group II (claims 11-19) drawn to a cryopreservation composition, and elect the species of DMSO (dimethyl sulfoxide) of claims 4 and 14 for initial examination. Applicants respectfully traverse the Restriction and Election of Species Requirement.

According to the Requirement, the invention of Group I (claims 1-10), drawn to a method of cryopreserving cells, is related to the invention of the claims of Group II as process of use and product. It was asserted that the inventions are distinct because the process of using the product can allegedly be practiced with "any of a variety of other non-cyclohexanediol cryopreservatives such as alcohols and proteins."

Applicants respectfully submit that the reasoning in the Restriction Requirement is improper because the method of use requires the use of a cryopreservation composition containing at least one cyclohexanediol compound. Thus, the allegation that the process of using the product could be practiced with any of a variety of other non-cyclohexanediol cryopreservatives such as alcohols and proteins is not agreed with in view of the explicit recitations in claim 1.

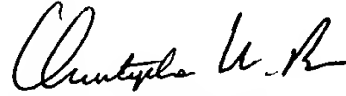
Further, according to MPEP §803, there are two requirements that must be met before a proper Restriction Requirement may be made. These two requirements are: "The inventions must be independent . . . or distinct as claimed; and there must be a serious burden on the Examiner if restriction is not required . . . " (emphasis added). Applicants respectfully submit that the Office Action has also failed to establish the second requirement set forth in MPEP §803, that a serious burden exists on the Examiner if restriction is not required between the Groups of claims.

As discussed above, both the method of cryopreserving cells and the cryopreservation composition require the presence of a cyclohexanediol compound. In view of this, it is respectfully asserted that the search and examination of the entire application could be made without serious burden. MPEP §803 states that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added).

For at least the foregoing reasons, and in order to avoid unnecessary delay and expense to applicants and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn. Early and

favorable action on the merits with respect to all of pending claims 1-19 is respectfully requested.

Respectfully submitted,



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Date: July 31, 2002

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